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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,478	10/24/2003	Takashi Okazawa	CFA00014US	3444

34904 7590 05/27/2008  
CANON U.S.A. INC. INTELLECTUAL PROPERTY DIVISION  
15975 ALTON PARKWAY  
IRVINE, CA 92618-3731

EXAMINER
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GARCIA, GABRIEL I

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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05/27/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/692,478	<b>Applicant(s)</b> OKAZAWA, TAKASHI	
	<b>Examiner</b> GABRIEL I. GARCIA	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/24/03 &amp; 3/4/08</u> .                                   | 6) <input type="checkbox"/> Other: ____.                          |

### **Part III DETAILED ACTION**

1. This application has been examined. Claims 1-13 are pending in this application.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 10-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 10-13 are directed to non-statutory subject matter. Claims 10-13 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a)

(functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer -readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structure do not define any structural or functional interrelationships between the data structure and other claimed aspects of the

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invention which permit the data structure's functionality to be realized.”

Claims 10-13, while defining a computer program for a configuration information of a network interface does not define a “computer-readable medium” and is thus non-statutory for that reasons. A computer program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody on “computer-readable medium” in order to make the claim statutory.

“In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.”-MPEP 2106.IV.B1(a).

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shima et al. (6,819,443) in view of Shiohara (6,804,019).

With regard to claim 1, Shima et al. teaches a printing (e.g. figs. 1-5) comprising: a print control device (39); a network interface (41) device that is connecting the print control device (39) to a network (9); an information processing device (3) that is connected to the print control device (39) through an interface different (33) from the network interface device (41); an acquisition unit, arranged in the print control device, for acquiring information of the interface device from the network interface (reads on figs 1-3, clearly information can be acquire from the information processing device (or host) relating to the communication task of the interface), and transmitting unit for transmitting information acquired by the acquisition unit from the print control device to the information processing device through the interface different from the network interface device (reads on figs 1-3, clearly information can be transmitted when it is received from the network interface to the information processing device by using the parallel port of the printing device; and generating unit, arranged in the information processing device, for generating print data representing the information of the network interface device based on the information transmitted from the transmitting unit (reads on fig. 3, which describes how the data can be generated and can be transmitted to the printing device). Shima et al. does not teach the acquiring information being configuration information. Shiohara (in the same field of endeavor, “network printing”) teaches that it is well known in the art

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at the time of the invention device to send network configuration to a printing device (e.g. figs. 1-2).

Therefore, it would have been obvious to one of ordinary skill in the art to provide the means to use the network configuration information as taught by Shiohara to the system of Shima et al. because of the following reasons: 1) it would allow the system of Shima et al. to use different network configuration allowing different computers system to use the printing device, and 2) as suggested by Shiohara in col. 2, lines 7-20.

With regard to claim 2, the combination of Shima et al. and Shiohara teach the use of the transmitting and communication of network configuration information and the ability for the printer to communicate information through a different interface (parallel), (see claims 1 above) and Shima inherently suggests using commands to get information back and forth between the image processing device and the printing device (see figs 1-3, clearly the communication interfaces 33 or 41 allow user to receive and send commands to the printer such as resource information).

With regard to claim 3, the combination of Shima et al. and Shiohara teach the use of the network configuration information (see claims 1 above) and Shima teaches a dedicated signal line to acquire the information of the network interface device (reads on fig. 2, which depicts a dedicated signal line between the CPU and the network interface) .

With regard to claim 4, the combination of Shima et al. and Shiohara teach the use of the network configuration information (see claims 1 above) and Shiohara

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further teaches the use of a predetermined format (reads on figs. 4 and 5) .

Therefore, it would have been obvious to one of ordinary skill in the art to provide the means to use the network configuration information having a predetermined format as taught by Shiohara to the system of Shima et al. because of the following reasons: 1) it would allow the system of Shima et al. to use different network configuration allowing different computers system having different format to use the printing device, and 2) as suggested by Shiohara in col. 2, lines 7-20.

Shima teaches a dedicated signal line to acquire the information of the network interface device (reads on fig. 2, which depicts a dedicated signal line between the CPU and the network interface) . .

With regard to claims 5-9, the limitations of claims 5-9 are covered by the limitations of claims 1-4 above.

With regard to the computer program code claims 10-13, the limitations of claims 10-13 are covered by the limitations claims 1-4 above. The steps of the system claims 1-4 can be program within the memory of Shima.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shima (2006/0072156) teaches a network printer connected by a network.

Tominaga (2003/0033368) teaches an image forming system, image forming method, and server.

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7 Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Gabriel I. Garcia** whose telephone number is (571) 272-7434. The examiner can normally be reached Monday-Thursday from 7:30 AM-6:00 PM.. The fax phone number for this group is (571) 273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2600.

/Gabriel I Garcia/

Primary Examiner, Art Unit 2625



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**Gabriel I. Garcia**  
**Primary Examiner**  
May 13, 2008